

REMARKS

Amendments to the Claims

Entry of the above amendments to the claims is respectfully requested. Applicants gratefully acknowledge the allowance of claims 46-50, 52-62, 65-69 and 72. Claims 1-2, 30, 33-42 and 45 have been canceled without waiver or prejudice by this amendment.

Claim 3 has been amended by making it an independent claim. Support for this amendment is in claims 1-3 as originally filed and in the specification at page 4, line 21 through page 5, line 9. Claim 11 has been amended by limiting the definition of the estrogen agonist/antagonist and prostaglandin or prostaglandin agonist/antagonist to those specifically recited therein. Support for this amendment is in the specification at page 5, line 10 through page 6, line 3 and in claims 12 and 13 as originally filed. Claim 12 has been amended by deleting the terms "tamoxifen, and 4-hydroxy-tamoxifen" from the definition of the estrogen agonist/antagonist. Support for this amendment is in the specification and in claim 12 as originally filed. Claim 13 has been amended by making it depend from claim 12 rather than claim 11 and by deletion of the term "PGF₂ α " from the definition of the prostaglandin or prostaglandin agonist/antagonist. Support for this amendment is in the specification and claim 12 as originally filed. Applicants respectfully submit that no new matter has been added by these amendments.

The 35 U.S.C. § 112 First Paragraph Rejection

Claims 1-2, 11-12, 30 and 33 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Claims 1-2, 30 and 33 have been canceled by this amendment and therefore the rejection is moot with respect to those claims.

Applicants respectfully submit that claims 11-12, as amended, are clear, concise and exact such that one skilled in the art could readily practice the claimed method. Claims 11 and 12 have been amended by limiting the estrogen agonist/antagonist and prostaglandin or prostaglandin agonist/antagonist to those specifically recited therein. Thus claims 11-12 particularly disclose specific combinations to be employed in methods of treating a condition that presents with low bone mass. One skilled in the art, in view of the written description and guidance provided in the specification, would readily be able to practice the methods of claims 11-12. For this reason, applicants respectfully request that the Examiner reconsider

claims 11-12, as amended, and withdraw the rejection of those claims under 35 U.S.C. § 112, first paragraph.

The 35 U.S.C. § 103(a) Rejection

Claims 34-42 and 45 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Bachmann, G.A. et al. (1994). Applicants submit that the cancellation of these claims renders the present rejection of these claims moot.

Conclusion

Applicants, having addressed all points and concerns raised by the Examiner, believe that the application is in condition for allowance and respectfully request an early and favorable action in light of the foregoing amendment and remarks.

Respectfully submitted,

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Pfizer Inc.
Patent Department, MS 8260-1611
Eastern Point Road
Groton, Connecticut 06340
(860) 715-6645

/ John A. Wichtowski /
John A. Wichtowski
Attorney for Applicant(s)
Reg. No. 48,032